

### **REMARKS**

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-11 remain pending, with claims 8-11 previously indicated as being withdrawn from consideration. Claims 1 and 8 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

#### ***Restriction Requirement***

In response to Applicants' continued traversal of the restriction requirement, the Examiner asserts that the method of claim 8 "does not require the specific device of claim 1 to perform the steps [of the method]" and that "[t]he method can be performed by [a] materially different apparatus." *Office Action, page 2*. Without necessarily acquiescing to the Examiner's arguments, through this Reply Applicants have amended claims 8-11 to definitively correspond to the device as recited in the apparatus claims. Accordingly, Applicants respectfully request reconsideration of the restriction requirement and substantive examination of the method claims.

#### ***35 U.S.C. § 112, 2nd Paragraph Rejection***

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Regarding claim 1, although Applicants do not necessarily agree with the Examiner's assertion of indefiniteness, Applicants have amended claim 1 to recite, *inter alia*, "*a primary means for moving the suction plunger to receive a sample; and a secondary means for increasing a speed of the suction plunger during an emptying movement to dispense the sample*" in order to expedite prosecution. In other words, in addition to a primary means which moves the suction plunger to receive a sample, the claimed invention comprises a secondary means that increases the speed of the plunger in an emptying movement to dispense the sample. Applicants respectfully submit that the amended limitations are clear and definite.

Claims 2-3 have been amended to address the alleged antecedent basis issues. Claim 4 has been largely redrafted in response to the Examiner's allegations of indefiniteness. Claims 5-6 have been amended to recite further structure of the device.

In view of the foregoing, Applicants respectfully request that the §112, second paragraph rejection of claims 1-7 be withdrawn.

***Claim Rejections - 35 U.S.C. §102***

Claims 1-2 and 5-6 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,330,717 to Berteloot et al. (“Berteloot”). [Based on the recitation in page 5, item 10 of the Office Action, Applicants infer that the Examiner intends to reject claims 1-2 and 5-7 in view of Berteloot.] Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02.* Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent claim 1 recites, *inter alia*, the features of, “*a primary means for moving the suction plunger to receive a sample; and a secondary means for increasing a speed of the suction plunger during an emptying movement to dispense the sample*”. Applicants respectfully submit that the Berteloot reference cannot disclose all of the elements of claim 1.

Berteloot discloses an electropneumatic apparatus connectable to a computer for rapidly sampling mixtures contained in a reactor 4 through a bottom aperture 12. (See Berteloot, Figure 1 and Abstract.) The apparatus further comprises an injector 2 which is attachable to the reactor 4 in order to introduce a reagent into reactor chamber 10 via pipette 18. The injector 2 comprises a rod 20 with an end inserted into pipette 18. The rod 20 is driven by a piston 24 to eject the reagent out of the pipette 18. The piston 24 drives the rod through the force released by the compressed return spring 26 when pin 28 is removed by a user. (See col. 3, lines 39-52.) The Examiner relies upon the piston and spring combination of Berteloot to allegedly cover the secondary means of the claimed invention. However, clearly the injector disclosed by Berteloot cannot anticipate both of the primary and secondary means of the claimed invention.

First, Berteloot discloses only one means for moving the rod 20: the return spring 26. Berteloot is completely silent regarding an apparatus comprising any additional means for moving said rod.

Second, the return spring of Berteloot is disclosed only as a means for driving the rod to introduce the reagent disposed within pipette 18 into the reactor chamber 10. (See col. 3, lines 45-52.) In contradistinction, claim 1 recites *primary means for moving the suction plunger to receive a sample*. Berteloot only uses the rod 20 to introduce the sample from the pipette into the chamber 10. Berteloot does not disclose or suggest any means for moving the rod to receive a sample into pipette 18. Furthermore, Applicants submit that rod 20 is not the same as the suction plunger of the claimed invention, and the rod is not drivable to receive the reagent into pipette 18.

To illustrate this point, Berteloot expressly discloses that the injector comprises a plastic bottom part serving as pipette holder 16 that may be screwed in and out of the reactor 4. The upper part of injector 2 containing the return spring piston system is screwed on the plastic bottom part. (See col. 7, lines 11-17.) In order to set up the reagent for insertion into the reactor chamber, Berteloot expressly discloses that:

“...from 5-40  $\mu$ l of vesicles are manually loaded inside a pipette tip and the vesicle-containing tip is introduced into the bottom part of the vesicle injector already screwed on top of the incubation chamber. The upper part of the vesicle injector is then screwed in its bottom part with the piston rearmed and maintained in its up position with the pin.” (Col. 11, lines 28-34; emphasis added.)

In other words, *the rod is never driven to receive a sample* into the pipette 18 since Berteloot expressly discloses that the reagent is preloaded into the pipette tip *before the piston mechanism is attached to the bottom part of the injector*. Accordingly, Berteloot cannot disclose or suggest a *primary means for moving the suction plunger to receive a sample*, as recited in independent claim 1.

Therefore, at least because Berteloot fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Dependent claims 2-7 are also distinguishable from the prior art at least due to their dependence from claim 1, directly or indirectly.

Further with respect to claim 7, Berteloot cannot disclose or suggest a “hand-held pipettor” as claimed, as least because Berteloot is expressly directed to an injector that is clearly disposed as attached to a reactor 4. (See Figure 1.) Accordingly, Berteloot fails to disclose all of the elements of dependent claim 7.

Accordingly, Applicants respectfully request that the rejection of claims 1-2 and 5-7 under 35 U.S.C. § 102(b) be withdrawn.

***Claim Rejections - 35 U.S.C. §103(a)***

Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Berteloot in view of U.S. Patent No. 6,352,673 to Rainin et al. (“Rainin”). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, the combination of Berteloot and Rainin fails to teach or suggest each and every limitation of claims 3-4. As demonstrated above, Berteloot fails to teach or suggest both “*a primary means for moving the suction plunger to receive a sample and a secondary means for increasing a speed of the suction plunger during an emptying movement to dispense the sample*” as recited in claim 1. Rainin has not been, and indeed cannot be, relied upon to correct at least this deficiency of Berteloot. Dependent claims 3-4 are also distinguishable from the prior art at least due to their dependence from claim 1, directly or indirectly.

Therefore, Applicants submit that claims 3-4 are patentable over the combination of Berteloot and Rainin and respectfully request that the rejection of claims 3-4 under §103(a) be withdrawn.

**CONCLUSION**

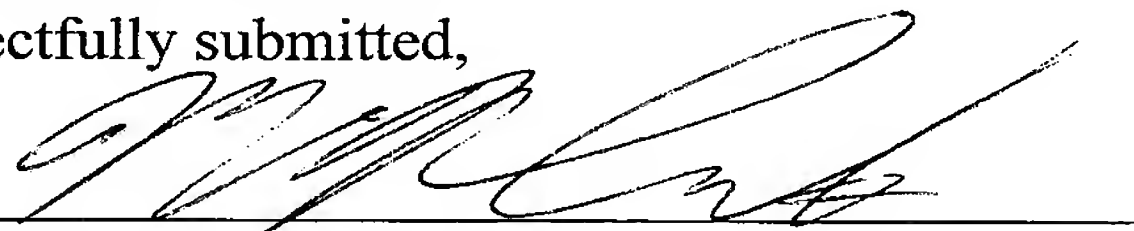
All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders (Reg. No. 60,166) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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